

Application Serial No.: 09/675,180
Reply to Office Action dated September 3, 2004,
and Notice of Non-Compliant Amendment
dated December 17, 2004

REMARKS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

The present Amendment reiterates the amendments and argument set forth in the Amendment filed on December 3, 2004. The Amendment filed on December 3, 2004, designating Claims 19 and 20 as being “(Previously Amended)” and Claims 32 and 33 as being “(Previously Added)” has been changed to designate Claims 19, 20, 32, and 33 as “(Previously Presented)” in order to address the Notice of Non-Complaint Amendment dated December 17, 2004.

Claims 19, 20, 32, and 33 are presently active in this case. Claims 1-18 and 21-31 having been canceled without prejudice or disclaimer.

The Applicants request acknowledgement of the consideration of the references cited in the Information Disclosure Statement filed on January 9, 2003, which includes U.S. Patent Nos. 4,259,958 and 5,730,739 that were cited in the PCT Written Opinion. Additionally, the Applicants request the listing of the Bloch et al. reference (U.S. Patent No. 5,780,150) on a PTO Form 892, since this reference was cited in the outstanding Official Action and the Official Action dated November 5, 2003, but never listed on a PTO Form 892.

Claims 11 and 13 were rejected under 35 U.S.C. 102(b) as being anticipated by Arakawa et al. (U.S. Patent No. 5,591,521). Claim 14 was rejected under 35 U.S.C. 103(a) as being unpatentable over Arakawa et al. in view of Bloch et al. (U.S. Patent No. 5,780,150).

Application Serial No.: 09/675,180
Reply to Office Action dated September 3, 2004,
and Notice of Non-Compliant Amendment
dated December 17, 2004

Claims 19, 20, 32, and 33 were rejected under 35 U.S.C. 103(a) as being unpatentable over Arakawa. For the reasons discussed below, the Applicants request the withdrawal of the art rejections.

Claims 11, 13, and 14 have been canceled, thereby rendering the rejections thereof moot.

Regarding Claims 19, 20, 32, and 33, the Applicants note that the basic requirements for establishing a *prima facie* case of obviousness as set forth in MPEP 2143 include (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, (2) there must be a reasonable expectation of success, and (3) the reference (or references when combined) must teach or suggest all of the claim limitations. The Applicants respectfully submit that a *prima facie* case of obviousness has not been established in the present case because (1) the reference does not teach or suggest all of the claim limitations, and (2) there is no suggestion or motivation to modify the reference to arrive at the present invention.

Claim 19 of the present application recites a backing sheet for insulation. The backing sheet comprises a front side having an adherent material thereon, a back side, a stapling tab extending along an edge of the backing sheet, where the stapling tab has a first portion of the back side positioned against a second portion of the back side, and at least one

Application Serial No.: 09/675,180
Reply to Office Action dated September 3, 2004,
and Notice of Non-Compliant Amendment
dated December 17, 2004

hole extending through the backing sheet such that a portion of the adherent material extends through the at least one hole and contacts the back side.

As noted in the Official Action, the Arakawa reference fails to disclose at least hole extending through the backing sheet such that a portion of the adherent material extends through the at least one hole and contacts the back side. The Official Action notes that the Arakawa et al. reference, however, discusses an adhesive tape having a hole. However, the Applicants respectfully submit that the Arakawa et al. reference clearly and expressly teaches away from the use of such a hole in the discussion of the background of the invention in column 1, lines 18-52, thereof. The Arakawa et al. reference states “there are problems that the adhesive is exuded through such a penetrated hole to make rewinding impossible and the tape becomes sticky to use to give an unpleasant feeling to the customer.” (Column, 1, lines 39-42.) Thus, the Arakawa et al. reference teaches away from the use of such a hole, due to the problems annunciated above. Accordingly, the Arakawa et al. reference teaches a configuration for an adhesive tape that does not include such a hole.

As noted in MPEP 2141.0, the references must be considered in their entirety, including the disclosures that teach away from the claims. Furthermore, the Applicants submit that modifying the invention taught in the Arakawa et al. reference to include a hole would render the invention unsatisfactory for its intended purpose, based upon the teaching in the background of the invention section of the Arakawa et al. reference by making rewinding impossible and by making the tape sticky to use and giving an unpleasant feeling to the

Application Serial No.: 09/675,180
Reply to Office Action dated September 3, 2004,
and Notice of Non-Compliant Amendment
dated December 17, 2004

customer. As noted in MPEP 2143.01, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. Thus, no motivation existed to modify the invention described in the Arakawa et al. reference to arrive at the present invention recited in Claim 19.

Therefore, the Applicants respectfully submit that the rejection is based on the improper application of hindsight considerations. It is well settled that it is impermissible simply to engage in hindsight reconstruction of the claimed invention, using Applicants' structure as a template and selecting elements from the references to fill in the gaps. *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991). Recognizing, after the fact, that a modification of the prior art would provide an improvement or advantage, without suggestion thereof by the prior art, rather than dictating a conclusion of obviousness, is an indication of improper application of hindsight considerations. Simplicity and hindsight are not proper criteria for resolving obviousness. *In re Warner*, 397 F.2d 1011, 154 USPQ 173 (CCPA 1967).

Accordingly, the Applicants respectfully request the withdrawal of the obviousness rejection of Claim 19.

Claims 20, 32, and 33 are considered allowable for the reasons advanced for Claim 19 from which they depend. These claims are further considered allowable as they recite other

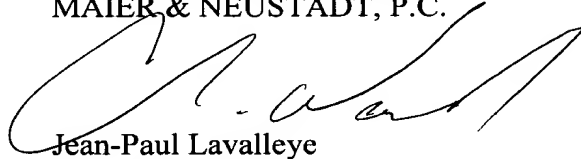
Application Serial No.: 09/675,180
Reply to Office Action dated September 3, 2004,
and Notice of Non-Compliant Amendment
dated December 17, 2004

features of the invention that are neither disclosed, taught, nor suggested by the applied references when those features are considered within the context of Claim 19.

Consequently, in view of the above discussion, it is respectfully submitted that the present application is in condition for formal allowance and an early and favorable reconsideration of this application is therefore requested.

Respectfully Submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Jean-Paul Lavalleye
Registration No. 31,451
Attorney of Record

Christopher D. Ward
Registration No. 41,367

Customer Number

22850

Tel. (703) 413-3000
Fax. (703) 413-2220
(OSMMN 10/01)

JPL:CDW:brf

I:\atty\cdw\192400US55X\am7.doc